

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.	:	09/925,586	Confirmation No. 2981
Applicant	:	Nassiff, <i>et al.</i>	
Filed	:	August 9, 2001	
TC/A.U.	:	3661	
Examiner	:	Broadhead, Brian J.	
Docket No.	:	BOC9-2000-0032 (178)	
For:	:	VEHICLE NAVIGATION METHOD	

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**RESPONSE TO OFFICE ACTION**

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MAIL STOP AMENDMENT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Final Office Action mailed January 25, 2006 (Office Action),  
please amend the above-identified application as follows:

**Amendments to the Claims** are reflected in the Listing of Claims which begins  
on page 2 of this submission.

**Remarks/Arguments** begin on page 4 of this submission.

**Conclusion** begins on page 9 of this submission.

This listing of claims will replace all prior versions and listings of claims in the instant application:

### LISTING OF CLAIMS

Claims 1-18. (Cancelled)

19. (Previously Amended)

A method for vehicle navigation comprising the steps of:

- accessing a publicly accessible Web site using a computing device that is remote from a vehicle;
- identifying within said Web site at least one destination;
- automatically determining navigation information for said destination, wherein at least a portion of said navigation information includes geographic coordinates for said destination;
- storing said navigation information in a memory, wherein said memory is remote from said vehicle;
- providing a portable storage media, wherein said memory is within said portable storage media;
- transferring said portable storage media to a self-contained, in-vehicle navigation device in order to transfer said navigation information;
- determining whether a data format of said navigation information conforms to data requirements of said in-vehicle navigation device prior to transferring said navigation information; and
- converting said data format of said navigation information to an alternate data format prior to transferring said navigation information if said data format does not conform to data requirements of said in-vehicle navigation device.

20-25. (Cancelled)

26. (Previously Amended) A machine-readable storage having stored thereon, a computer program having a plurality of code sections, said code sections executable by a machine for causing the machine to perform the steps of:

accessing a publicly accessible Web site using a computing device that is remote from a vehicle;

identifying within said Web site at least one destination;

automatically determining navigation information for said destination, wherein at least a portion of said navigation information includes geographic coordinates for said destination;

storing said navigation information in a memory, wherein said memory is remote from said vehicle;

providing a portable storage media, wherein said memory is within said portable storage media;

transferring said portable storage media to a self-contained, in-vehicle navigation device in order to transfer said navigation information;

determining whether a data format of said navigation information conforms to data requirements of said in-vehicle navigation device prior to transferring said navigation information; and

converting said data format of said navigation information to an alternate data format prior to transferring said navigation information if said data format does not conform to data requirements of said in-vehicle navigation device.

## **REMARKS**

These remarks are made in response to the Office Action dated January 25, 2006 (Office Action). As this response is timely filed within the three-month statutory period, no fee is believed due.

In the Office Action, Claims 19 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,405,126 to Palomo, *et al.* (hereinafter "Palomo"), in view of U.S. Patent No. 6,405,123 to Rennard, *et al.* (hereinafter "Rennard"), and further in view of U.S. Published Patent Application No. 2002/0002438 to Ohmura *et al.* (hereinafter "Ohmura"). Claims 19 and 26 also were rejected in the Office Action under 35 U.S.C. § 112, first paragraph.

### **Applicants' Invention**

It may be useful at this juncture to reiterate certain aspects of Applicants' invention. One embodiment of the invention, typified by amended Claim 19, is a method of vehicle navigation. The method includes accessing a publicly accessible Web site using a computing device that is remote from a vehicle, and identifying within the Web site at least one destination. Additionally, the method includes automatically determining navigation information for the destination, at least a portion of the navigation information including geographic coordinates for the destination.

The method further includes storing the navigation information in a memory remote from the vehicle, and providing a portable storage media containing the memory. The method also includes transferring the portable storage media to a self-contained, in-vehicle navigation device in order to transfer the navigation information. Additionally, the method includes determining whether a data format of the navigation information conforms to data requirements of the in-vehicle navigation device prior to transferring the navigation information, and, if not, converting the data format to an alternate data format prior to transferring the navigation information to the in-vehicle navigation device.

**Applicants Have Not Failed To Disclose The Best Mode**

It is stated at page 2 of the Office Action that the requirements of 35 U.S.C. § 112, first paragraph, are not satisfied in this case because "the best mode contemplated by the inventor[s have] not been disclosed." It is further stated that "[e]vidence of concealment of the best mode is based upon the lack of disclosure of how to convert the format of the navigation information and what hardware or software [is] used to do the conversion."

A finding that an inventor has failed to disclose the best mode of invention requires evidence that the inventor (1) knew of a better mode than was disclosed, and (2) concealed that better mode. See High Concrete Structures, Inc. v. New Enterprises Stone and Lime Co., Inc., 377 F.3d 1379, 1382 (Fed. Cir. 2004); see also Bayer AG v. Schein Pharmaceuticals, Inc., 301 F.3d 1306, 1320 (Fed. Cir. 2002) and Teleflex, Inc. v. Ficosa North American Corp., 299 F.3d 1313, 1330-31 (Fed. Cir. 2002). Compliance with the best mode requirement is a factual, two-pronged inquiry. The first prong is subjective, focusing on the inventor's state of mind at the time the patent application was filed, and asks whether the inventor considered a particular mode of practicing the invention to be superior to all other modes at the time of filing. The second prong is objective and asks whether the inventor adequately disclosed the mode the inventor considered to be superior. See Amgen, Inc. v. Chugai Pharm. Co., 927 F.2d 1200, 1212 (Fed. Cir. 1991). Accordingly, a failure to disclose a better mode will not invalidate a patent if the inventor, at the time of filing the application, did not know of a better mode or did not appreciate that it was superior. MPEP § 2165.

In the present case there is no evidence that Applicants considered any one technique of data format conversion superior to any other; indeed, Applicants' invention applies to various such techniques embodied in different or operable with different combinations of hardware and/or software. In such cases it has long been held that "where there are several methods known to those skilled in the art, the mere failure to disclose the particular method selected does not amount to concealment of best mode." Hybritech, Inc. v. Abbott Laboratories, 4 USPQ2d 1001, 1012 (C.D. Calif. 1987), *aff'd*, 849 F.2d 1446 (Fed. Cir. 1988).

Data format conversion is not the crux of Applicants' invention, but rather one element of a broader method of providing vehicle navigation. Applicants' invention addresses problems such as the problematic ergonomics associated with date entry in the context of vehicle navigation. *See, e.g., Specification*, p. 2, lines 4-12. Data format conversion is employed, but no particular one technique is superior to another, and Applicants' invention applies broadly to various techniques. The particular techniques of data format conversion, in turn, can vary depending on which of any number of different hardware and/or software combinations is employed with a particular vehicular system.

Applicants' invention relies on a combination of features relating to vehicle navigation. Data format conversion is among those features, but it is the combination with the other features, not the particular technique, software, or hardware for effecting the conversion that makes up the claimed invention. This last consideration weighs heavily in any best mode analysis: "it is concealment of the best mode of practicing the *claimed invention* that section 112 ¶1 is designed to prohibit." *Randomex, Inc. v. Scopus Corp.*, 849 F.2d 585, 588 (Fed. Cir. 1988); *see also Zygo Corp. v. Wyko Corp.*, 79 F.3d 1563, 1567 (Fed. Cir. 1996). Applicants' *claimed* invention is not affected by which of any of different data format conversion techniques are employed. Nor does any particular software and/or hardware among various different combinations affect the *claimed* invention. There are several such techniques and hardware-software combinations "known to those skilled in the art, and accordingly the mere failure to disclose the particular [ones] selected does not amount to concealment of best mode." *Hybritech, Inc. v. Abbott Laboratories*, *above*.

#### **Applicants' Invention Predates Ohmura**

Claims 19 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Palomo in view of Rennard and further in view of Ohmura. Applicants respectfully disagree that the combination of Palomo, Rennard, and Ohmura render the claims obvious. Applicants respectfully submit, however, that the issue is moot because Applicants' invention predates Ohmura.

Applicants conceived of their invention at least as early as April 13, 2000, and actively pursued its reduction to practice from a time prior to June 28, 2000, a date well prior the June 28, 2001, effective date of Ohmura based on a U.S. patent application filing. See *In re Hilmer*, 359 F.2d 859, (CCPA 1966), cited at MPEP § 2136.03. In support of their assertion, Applicants submit the Declarations attached hereto. The Declarations establish conception and continuing diligence from a time prior to the effective date of Ohmura through to the filing of the Application.

The Declarations are being filed along with a copy of Confidential Invention Disclosure No. BOC8-2000-0031, entitled "*Trip Planner*" (hereinafter "the Disclosure"). The Disclosure was submitted by Applicants on April 10, 2000, to an intellectual property professional employed by the assignee of Applicants' invention, International Business Machines Corporation (IBM). The Disclosure was modified on April 13, 2000. Subsequent to April 13, 2000, the disclosure was not revised. The Disclosure demonstrates proof of conception for the claimed subject matter of the Applicants' invention at least as early as April 13, 2000.

The Disclosure is an IBM confidential disclosure form. It is a standardized document that, according to established IBM procedures, is used by IBM inventors to disclose the conception of an invention. The procedures established by IBM govern the internal use of all such confidential disclosure forms. One aspect of IBM's procedures governing the use of such confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after its submission to an IBM Attorney/Patent Professional.

The present application, including each claim, was prepared based upon the attached Applicants' Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures, the inventors reviewed the Application prior to its submission to the U.S. Patent and Trademark Office in order to ensure that the claims and written description contained therein were fully supported by the Disclosure.

Moreover, Applicants exercised due diligence from prior to the effective date of Ohmura up through the date that the Application was filed. Specifically, as expressly affirmed in their Declarations, Applicants from at least April 13, 2000, through the filing of the Application on August 9, 2001, worked diligently with outside counsel to prepare and file the Application. Consistent with professionally-accepted practices, outside counsel prepares cases on a first-in, first-out basis, even though applications associated with specific bar dates are granted priority within the work queue. Outside counsel followed this professionally-accepted practice with respect to the Application in this case. Further evidence in the form of correspondence with outside counsel are also submitted herewith. The correspondence provide specific dates showing that after an internal review and patent search, Applicants' disclosure was sent to outside counsel. The correspondence further show that outside counsel prepared a draft for Applicants' review, and, after the review, filed the instant Application.

Applicants respectfully note that the Declarations and Disclosure were not previously submitted because Applicants' conception of the invention and diligence were not previously in issue. The issue has been raised now by the introduction of the reference, Ohmura, which was not previously cited. Accordingly, Applicants respectfully assert that their submission of the Declarations and Disclosure, submitted herewith, is timely.



## CONCLUSION

Applicants believe that the application in its present form is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

AKERMAN SENTERFITT

Date: April 25, 2006



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Gregory A. Nelson, Registration No. 30,577

Richard A. Hinson, Registration No. 47,652

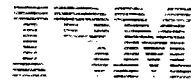
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6/69-178

July 19, 2000

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9/19/00 Rem.  
11/19/00  
12/19/00 - file put  
today

REF: Invention Disclosure: BOC8-2000-0031  
Title: TRIP PLANNER  
IBM Docket: BOC9-2000-0032

Dear Steve,

Please prepare and file the above referenced case with the U. S. Patent and Trademark Office. A copy of the invention disclosure and technical evaluation are enclosed for your use in preparing the application in accordance with IBM's format.

Thank you for your assistance in this matter.

Sincerely,

*Richard A. Tomlin*

Richard A. Tomlin  
Consulting Attorney

Enclosures

DOCKETED JUL 24 2000

# AKERMAN SENTERFITT

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<b>PLEASE DELIVER THE ACCOMPANYING TELECOPIED MATERIAL TO:</b>	<b>TRANSMITTAL DATE:</b> Mar 28, 2001
<b>NAME:</b> Steven G. Woodward	<b>CLIENT/MATTER NO:</b> 6169-178
<b>PHONE:</b>	<b>TOTAL PAGES:</b> 18
<b>FIRM/COMPANY NAME:</b>	<b>CITY, STATE:</b>

**SENDER'S NAME:** Steven Greenberg

## Comments from Sender:

Draft applicaiton for your review

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March 28, 2001

Steven G. Woodward  
IBM Corporation  
1555 Palm Beach Lakes Blvd.  
6th Floor  
West Palm Beach, FL 33401

**Re: New Patent Application  
VEHICLE NAVIGATION METHOD  
IBM Docket: BOC9-2000-0032; Our Ref: 6169-178**

Dear Steve:

Enclosed please find a draft of a patent application for the above-identified matter. Please review it carefully to ensure that the description of the invention accurately recites all of the invention's characteristics in the broadest possible manner, while also explaining, in detail, the preferred embodiment of the invention. The drawings should also be reviewed to confirm that they accurately depict the various details of the invention as you understand them. Finally, please read through the numbered claims at the end of the application. The claims will define the scope of protection any patent issuing from this application will provide. Accordingly, you should review them to ensure that they do not unduly restrict the scope of the invention by including any unnecessary detail. After you have reviewed the application, please call me with any comments you may have.

Please recall that patent applicants have a duty to disclose to the United States Patent Office all reasonably pertinent prior art of which they are aware. Failure to do so can jeopardize the validity of any patent issuing from an application. Accordingly, should you become aware of such references at any time during the pendency of this application, please let us know.

Very truly yours,

**AKERMAN SENTERFITT**

  
Steven M. Greenberg

SMG/kmw  
Enclosures

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July 27, 2001

Mr. Huifang Wang  
708 Russett Terrace  
Sunnyvale, CA 94087

**Re: New Patent Application**  
**VEHICLE NAVIGATION METHOD**  
**Our Ref: 6169-178**

Dear Huifang:

Enclosed please find a final draft of the above-identified patent application together with the Declaration and Power of Attorney, Assignment and Oath and Assignment for Taiwan. If the application is acceptable, please sign and date the enclosed documents where indicated and forward the original documents together with the application to Steven Woodward in the envelope provided.

Please feel free to contact me if you should have any questions or comments.

Very truly yours,

**AKERMAN SENTERFITT**



Steven M. Greenberg

SMG/kmw  
Enclosures

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August 9, 2001

Ms. Elaine Venturelli  
IBM Corporation  
1798 NW 40th Street  
Internal Zip 2106  
Boca Raton, FL 33431

**Re: New U.S. Patent Application  
VEHICLE NAVIGATION METHOD  
IBM Docket: BOC9-2000-0032; Our Ref: 6169-178**

Dear Elaine:

Please be advised that the above-referenced application was filed in the United States Patent and Trademark Office (USPTO) on August 9, 2001. Enclosed for your records are copies of all papers as filed as well as the diskette and the Oath and Assignment for the Republic of China.

In order to continue to satisfy the strictly enforced duty of disclosure under U.S. practice, please promptly advise us of any additional prior art information which is now known or which may become known to those involved in the preparation or prosecution of this application, and which the U.S. Examiner may deem relevant to patentability of the claims. Such information should include any commonly assigned patents and pending applications disclosing and/or claiming closely related subject matter.

In order to avoid possible late fees, all such additional information which is now known should be sent to us in sufficient time for filing by **November 9, 2001**. For information which may later become known, please send us such information in sufficient time for filing within three months from the date the information was first known to anyone involved in the preparation or prosecution of this application, together with the date the information was first known.

We will keep you promptly informed of further developments as they occur. In the meantime, if you have any questions, please do not hesitate to contact us. As always, thank you for allowing us to be of service to you in this matter.

Very truly yours,

AKERMAN SENTERFITT



Steven M. Greenberg

SMG/djt  
Enclosures